

Remarks

This amendment is responsive to the official action of Paper No. 5, mailed May 30, 2003. No new matter is presented.

A petition for extension of time is submitted herewith with the required fee (\$930). Also submitted is the fee for submitting two independent claims over the three permitted under the basic filing fee (\$168), and three additional total claims over the number for which fees were previously paid (\$54).

Status of the Claims Examined

In a supplemental action (Paper No. 10), the examiner states that applicant's preliminary amendment filed February 5, 2003 (Paper No. 9) was received after the official action of Paper No. 7 had been mailed, and did not affect the official action. Applicant infers that the preliminary amendment had not been entered at the time that the official action was taken.

A number of alternative expressions and other informalities in the claims, including certain improper multiple dependencies, were corrected in the preliminary amendment, but are subject to rejections or objections in the present official action.

The preliminary amendment was actually submitted and received at the PTO as indicated by the OIPE mailroom stamp one year earlier than the date mentioned in the official action. Therefore, applicant requests that any further official action be non-final so that applicant is provided with the opportunity to amend and obtain action after amendment. See 37 C.F.R. §1.115, which suggests that a preliminary amendment may be declined entry, but also suggests that the grounds for declining entry is that the preliminary amendment is filed during preparation of an official action, which is not the case.

Applicant infers from the examiner's statements in Paper No. 10 that the preliminary amendment has now been entered. Therefore, this amendment is based on the most recent state of the claims, assuming that the preliminary amendment is of

record. As a result, it is unclear on the record as to whether the examiner would withdraw or continue to maintain certain grounds of rejection. This factor also mitigates against making any second official action final.

There is an indication of allowable subject matter in the official action as to claims 6, 7 and 9. Applicant seeks to place the case in condition for allowance by amending claim 1 to incorporate the subject matter of claim 9; submitting new claim 30 that incorporates the subject matter of original claims 1 and 6; and submitting new claim 28 that combines the subject matter of claims 1 and 7. Thus the indication of allowable subject matter appears to apply to claims 1-5, 8 10-13, 16, 17, 19-30, 34 and 35, which all incorporate or depend from the subject matter considered allowable if placed in proper form.

Claim 31 is based on original claims 1 and 14. Claim 34 is based on original claims 1 and 21. These claims are also believed allowable but the subject matter was not treated in the official action due to objections regarding multiple dependent form. Claims 18 and 31-35 are pertinent. Reconsideration is requested because the multiple dependent form of these claims had already been removed in the preliminary amendment mentioned above.

Reconsideration and allowance of all the pending claims are requested.

Election of Species Responsive to Requirement of Restriction

At paragraph 19 of the official action, it is stated that the claims are directed to patentably distinct species divided by the following groups of figures:

- Group I. Figs. 1a, 1b, 1c, 2a, 2b
- Group III. Figs. 6a, 6b, 6c
- Group IV. Figs. 7a, 7b, 7c, 7d
- Group V. Figs. 8a, 8b

Claim 1 was considered generic. Applicant requests that the restriction requirement be reconsidered and withdrawn in view of the claims as amended prior to

the official action. Specifically, it is not clear on the record why the identified figures are considered to be different species, or whether the Groups are complete, due to lack of listing of any Group II, or mention of Figs. 3-5.

In order to be properly responsive to the restriction to the applicant provisionally elects the species of Group I, Figs. 1a-1c, 2a-2b. This election is made with traverse.

The claims that have been indicated to be directed to allowable subject matter read on the elected species of Group I, except for original claim 6, now represented by new claim 30. Inasmuch as claim 6 has been examined and is considered directed to allowable subject matter, there is no basis to maintain the restriction requirement.

Claim 30 is directed to an embodiment with a subdivided shaft, and reads on the species of Figs. 6, 7, 8.

In view of the status of the application, applicant requests that the restriction requirement be withdrawn.

Objections/Rejections Based on Informalities

Applicant has reviewed the many matters to which the examiner objects in the official action on grounds of definiteness and form. A number of the objections were directed to matters that had been corrected by the preliminary amendment. Other objections have been attended to in accordance with the suggestions in the official action. Applicant requests reconsideration as to the remainder.

Several of the objections concern the recital of a "tip" versus a "tip device." Both terms plainly refer to the same element (10). Applicant has amended the claims to use the term "tip device (10)."

Several of the objections refer to expressions that are considered indefinite under US practice (e.g., "preferably . . .," and the like). Applicant has corrected several such expressions in the claims, but the official action also refers to others that were corrected earlier (e.g., paragraphs 26, 27 of the official action refer to matters corrected in the preliminary amendment).

As to claim 2, there is an objection to lack of antecedent basis for the inclination and the tip. The tip is now the "tip device" and antecedent basis is provided. The term "inclination" is now recited in claim 1. It may be noted that claim 1 encompasses the establishment of an inclination angle in a plane including the main axis, or changing such an inclination angle using the pivotably inclinable tip device.

As to claim 6, the connection was considered to lack antecedent basis. This aspect is now recited as a coupling. Claim 30 corresponds to original claim 6 in independent form. Antecedent basis is provided.

Claim 7 was subject to objection for alternative expressions and antecedent basis. Claim 7 has been rewritten for definiteness as independent claim 28, with an alternative "preferably" clause eliminated, the alternative now being definitely recited in dependent claim 29. The "pivot direction" is now recited as the pivot plane and antecedent basis is provided in claim 28.

Applicant has generally reviewed and amended the claims for proper antecedent basis and expressions that are definite under US practice. Reconsideration and withdrawal are requested of the rejections under 35 U.S.C. §112.

Substantive Issues

A number of the original claims were rejected as anticipated or obvious over Garvey (US 1687647), Ganter (DE 801614), Bacou (FR 1253384), alone or combined with Malm (US 3420610). However allowable subject matter was indicated as to claims 6, 7, 9, now corresponding to claims 1-5, 8, 10-13, 16, 17, 19-30 and 35. Applicant need not comment on the references as to these claims. Allowance is requested.

As to claims 31, 34 and the claims depending therefrom (i.e, claims 31-34 and 18), these claims are now presented in proper form for examination and are also believed allowable. Reconsideration is requested. Applicant can briefly comment on the cited references in view of the claims that remain to be considered.

Garvey discloses a tip that deflects radially from axial or lateral pressure during writing so as to open or enlarge a flowpath for the writing fluid. See col. 1, lines 10-17. The deflected position is not controlled by a mechanical action or retained after the pressure of writing is released. Garvey does not disclose or suggest that it would be possible or desirable to have a adjustable degree of inclination as defined in applicant's claim 34 (which contains the subject matter of former claims 1 and 21). Without any capability of such adjustment, Garvey likewise does not disclose or suggest that particular use of a rotational element to obtain control of an inclination angle as in applicant's claim 31 (former claims 1 and 14).

The examiner suggests that Garvey teaches a longitudinal movement, which strictly speaking is not the case. Reconsideration is requested. Garvey may intend to open a gap between axially abutting elements as a sort of valve, but this is achieved by tilting the tip device when writing, and not from any longitudinal displacement. Even assuming that tilting is considered to include longitudinal displacement in a sense, which applicant respectfully submits would be a hindsight analysis, the pertinent language in applicant's claim 31 regarding control using the "terminal part" refers to the rear of the writing utensil as opposed to the front or nib end.

The Ganter reference has a particular structure of the ink carrying cartridge tube and roller-ball ink applying arrangements associated with it. The device is more akin to a refill than a writing utensil with a manually gripped shaft. Ganter has an ink cartridge with a stub end terminating in the ink roller ball. The stub end 'a' is affixed by a ball joint comprising a ball part 'c' held against the end of the shaft part 'b' by a nut 'd' that can be tightened to hold the angle of stub 'a' or loosened to allow the stub 'a' to be moved. The conical tip part of the Ganter device is not moved by any mechanism. It is loosened, manually moved and then tightened at a new position. Applicant's claim 34 recites that the inclination angle is controlled, and Ganter teaches away from that concept by providing an inclination that can only be set by loosening and re-tightening after manually setting an inclination, which is the opposite of control. Applicant's claim 31 defines a particular mechanism that produces the change in inclination, which is not

shown or suggested in the prior art. These claims are properly allowable over the prior art of record.

The official action includes an alternative rejection under Section 102 over Bacou. In that reference, the shaft part of the implement can be bent so that the graspable part, which is axially in line with the conical writing end, and become misaligned relative to the rear part. However, the conical nib end tip is not inclinable relative to the grasped shaft. Furthermore, as discussed above with respect to claims 31-35 and 18 versus Garvey, the bendable shank is not set at a particular angle but instead is only held resiliently by the user's grasp. And as discussed relative to Ganter, there is no control disclosed or suggested for determining an inclination angle as claimed. Therefore, claim 31-35 and 18 are properly allowable together with the claims for which allowable subject matter was previously indicated.

Drawing Changes

The official action objects to the drawings for certain matters that concern the numbering of the figures and the description in the specification. The figure descriptions have been amended to enable references collectively to sets of figure by number (e.g., figures 1), when the figures themselves are separately numbered (e.g., figs. 1a through 1d).

A proposal for drawing changes is submitted in a separate letter as required by the examiner. As also required under the revised format for amendments, applicant submits both annotated versions showing the changes made, and clean copy versions with the changes shown.

Conclusion

Applicant has made every effort to correct the application for formal matters and to place the claims into condition for allowance. Applicant requests the examiner's indulgence for any discrepancies between the claims examined and the claims as

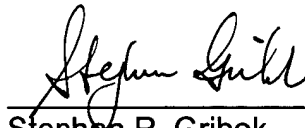
previously amended by the preliminary amendment filed in early 2002, which was unaccountably delayed.

The claims as amended are definite and in proper form for their dependencies and the like. The claims particularly and distinctly recite aspects that are not found or suggested in a similar device in the prior art. Applicant is pleased to note the indication of allowable subject matter as to certain claims. The differences between the invention and the prior art are such that the subject matter defined in all the pending amended claims, as a whole, is not shown to have been known or obvious. Reconsideration and allowance of all the pending claims are requested.

Respectfully submitted,

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